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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,212	09/01/2000	Anthony N. Cabot	AC-001	6136

7590

04/02/2002

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EXAMINER

LEGESSE, NINI F

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 04/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/654,212

Applicant(s)

CABOT, ANTHONY N.

Examiner

Nini F. Legesse

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED

FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: \_\_\_\_\_.
3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

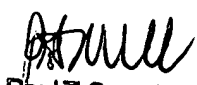
Claim(s) rejected: 1-7 and 21-32.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.

10. ☒ Other: Response to argument

  
Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700

The proposed amendments to the claims will not be entered and the final refection stands because they raise new issues that would require further consideration and/or search.

- In claim 1, lines 6-9, the limitations “discarding all face up cards that were not selected to be held in said NxN array of cards”, “all said discarded” and “randomly...all said discarded” are considered new issues.
- In claim 21, lines 6-7, the limitations “discarding all unselected cards” and “randomly selected” are considered new issues.
- In claim 29, lines 5-6, the limitations “discarding all unselected cards” and “randomly selected” are considered new issues.

### ***Response to Arguments***

Applicant's arguments filed in paper no. 12 have been fully considered but they are not persuasive.


Applicant argue that because he changed claims in response to a prior art rejection, that the Office is precluded from the application of new art and making that office action final. However, such is simply not office practice. If applicant amends a claim in response to a prior art rejection and that amendment avoids the previous rejection, the office is obligated to determine if the newly amended claims are patentable. If they are not, the subsequent rejection may be made final. See MPEP 706.07A, which specifically directs that “under present practice, second or any subsequent actions on the merits

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**shall be final**, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment..." (emphasis added). The practice argued by applicant simply is not office practice.

Applicant argues that Patent No. 6,220,959 to Holmes does not discard all face up cards. This limitation about which Applicant argues is simply not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable.

Applicant argues that examiner has taken Holmes and Dietz (US Patent No. 5,704,835) out of context to try to force them together. However, the Examiner recognizes that references cannot be arbitrarily combined and that there must some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA, 1969). In this case, Holmes and Dietz are both from the same art of video game machines wherein the randomly generated symbols are presented in NxN arrays. Dietz is relied upon merely to show that such randomly generated arrays can be other than 5x 5, such as 3x3.

  
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